

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Masahiro YAMAMOTO, *et al.*

Serial No.: 10/788,720

Filed: 27 February 2004

Title: SHIFT CONTROL SYSTEM IN BELT-TYPE
CONTINUOUSLY VARIABLE TRANSMISSION

Group Art Unit: 3682

Examiner: V. Johnson

Attorney Docket No.: KIOI:039

Confirmation No.: 6791

VIA EFS-WEB

16 MAY 2009

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

PETITION TO REVIVE UNDER RULE 137(b)

Sir:

Applicants petition to revive this application. This Petition is timely since it is filed within two months of the Notice of Abandonment mailed 27 March 2009. The required fee is addressed in the EFS-Web generated fee transmittal. The Commissioner, however, is authorized to charge any fees, including for the petition to revive, extension of time, excess claim fees, etc., required to maintain pendency of this application to Deposit Account No. 18-2056.

STATEMENT OF FACTS

1. Applicants filed an Appeal Brief, along with a Notice of Appeal, and a petition for a one-month extension, on 24 January 2008.
2. The examiner issued a Notice of Non-Compliant Brief on 24 November 2008, ten months after the Appeal Brief was filed, because the Appeal Brief alleged did not comply with Rule 41.37(c)(1)(v):
 - (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C 112, sixth paragraph, and/or (2) set forth the structure, material, acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
3. Since Rule 41.37(c)(1)(v) calls for multipart requirements and the examiner did not indicate what specific aspect of the Summary section is non-compliant, the undersigned held a telephonic conference with examiner Johnson and SPE Ridley to determine which part is problematic. See the Remarks of Reply to Notice of Non-Compliant Appeal Brief dated 05 December 2008.
4. During the telephonic conference, the examiners informed the undersigned that the problem with the Appeal Brief is due to the Summary section not identifying the specification by line numbers rather than paragraph numbers. Neither examiner Johnson nor Ridley identified any specific problem associated with the means-plus-function limitations now alleged to be non-compliant.
5. The Summary section of the Appeal Brief filed 05 December 2008 was revised to identify the specification by line numbers instead of paragraph numbers based on what examiners Johnson and Ridley said the problem was.
6. The Communication dated 24 March 2009 states that the Appeal is dismissed because "applicant has not overcome all reasons for noncompliance of which appellant was notified. Specifically, the examiner alleges that the Summary section does not

specifically point out what structure corresponds to the means-plus-function limitations.

7. The undersigned telephonically contacted examiner Johnson and SPE Ridley to determine how and why the Summary section is non-compliant when the Summary section explicitly defines what each means-plus-function limitation corresponds to:

The shift control system includes **shift control means** for controlling the shift actuator (27). The **shift control means corresponds to the shift control section (12b)**. See Fig. 2 and page 13, lines 25-27.

The shift control system further includes **speed detecting means** for detecting the vehicle speed. The **speed detecting means corresponds to a secondary pulley rotation sensor (14)**. See Figs. 1 and 2, and page 13, lines 19-21.

The shift control system further includes **downshift detecting means** for detecting a downshift. See page 13, lines 21-22, which states that step 303 constitutes the downshift detecting means, and page 11, lines 1-4, which states that the shift control section (12b) carries out the flow chart of Fig. 3. The shift control section (12b) determines whether the downshift is completed in step 303. See Fig. 3 and page 12, lines 1-5. Thus, the downshift detecting means corresponds to the shift control section (12b).

The shift control system further includes **idle state detecting means** for detecting an idle state of the engine. The **idle state detecting means corresponds to an idle switch (30)**. See Figs. 1 and 2, and page 13, lines 22-24.

Referring to Fig. 4, the shift control means (shift control section (12b)) limits the operating speed of the shift actuator (step motor 27) to prevent slippage of the V-belt when:

- (1) the speed detected by the speed detecting means (secondary pulley rotation sensor (14)) is less than a first predetermined speed (see Fig. 3, step 300, and page 11, lines 5-8);
- (2) the downshift detecting means (shift control section (12b), step 303) detects the downshift (see Fig. 3, step 303, and page 13, lines 3-5); and
- (3) the idle state detecting means (idle switch (30)) does not detect (i.e., idle switch off) the idle state of the engine (see Fig. 3, step 302, and page 13, lines 1-3).

See page 13, lines 11-17, where it explains that, from period

t2, when the condition of the steps 300-303 in Fig. 3 are all established, to period t6, when the conditions of the steps 305 to 307 are all established, the shift control section (12b) limits the operating speed of the step motor (27) by lowering the shift speed during periods t2 to t6. [Amended Appeal Brief, page 3, line 3 to page 4, line 30; Emphasis added].

8. According to examiners Johnson and Ridley, the Summary section of the Appeal Brief filed 05 December 2008 is defective because it does not identify the structural elements that correspond to the claimed means.
9. A Notice of Abandonment was mailed 27 March 2009.

PETITION TO REVIVE

Applicants submit that it was improper to dismiss the Appeal because (1) the Appeal Brief fully complies with the requirements set forth in Rule 41.37(c)(1)(v), and (2) the examiner did not properly identify how the Appeal Brief does not comply with Rule 41.37(c)(1)(v) to give applicants the opportunity to correct the alleged non-compliance.

Appeal Brief Complies with Rule 41.37(c)(1)(v)

During the telephonic conference of 25 March 2009, when asked what is exactly non-compliant with the Appeal Brief, examiner Johnson stated that the "shift control section 12b" referred to as corresponding to the claimed shift control means is not structural. The undersigned pointed out that the shift control section 12b is part of the transmission controller 12, which is clearly a structure. In response, the examiner indicated that the shift control section 12b is insufficiently described without giving any explanation as to why. It is incomprehensible how the shift control section 12b, which is part of the controller 12, can be construed as non-structural since a controller is a device.

The Summary section (1) identifies every means plus function and (2) identifies the corresponding structure the structure **TO THE EXTENT** described in the specification with reference to the specification by page and line number, and to the drawings, and by reference characters. Accordingly, the Appeal Brief fully complies with Rule 41.37(c)(1)(v).

During the follow-up telephonic conference, SPE Ridley alluded that the problem lies with improper description of the claimed shift control means encompassing another claimed limitation, namely the downshift detecting means. According to SPE Ridley, as both of these limitations correspond to the same transmission controller, it is somehow deemed improper. In other words, the problem identified by examiner Ridley is more closely related to a § 112 issue. If indeed that were the case, the PTO should have reopened prosecution so that this issue can be properly addressed before going forward with appeal. The problem indicated by the examiners in fact has nothing to do with complying with the Appeal Brief, but rather with a new issue uncovered by the examiners after the corrected Appeal Brief was filed.

Improper Notice

The Notice of Non-Compliant Brief was simply incomplete as it did not specifically point out the problem the examiner identified during the telephonic conference of 25 March 2009. The examiner(s) could have simply identified that the problem and could have explained the problem during the earlier telephonic conference held with examiner Johnson and SPE Ridley.

Applicants submit that the examiners did not identify the problem at the outset because it was not an issue at that time; only after the examiner reviewed the Summary section of the corrected Appeal Brief that the examiners decided that a new problem exists.

Applicants submit that it is facially improper and unfair to applicants to dismiss the Appeal as being non-compliant because the examiner failed to point to the alleged problem at the outset. Moreover, the alleged problem has nothing to do with meeting Rule 41.37(c)(1)(v), but rather with how the examiner is now construing the limitation and/or a new issue that is raised for the first time, namely a § 112 issue, which in fact is appealable subject matter. The claim construction should be left to the Board to decide since it is not merely a procedural issue but rather substantive. Alternatively, the examiner should have reopened prosecution.

Moreover, since the problems explicitly identified by the examiners during the earlier interview was overcome, the examiner should have issued a second Notice of Non-Compliant Brief, specifically identifying the issues raised during the latter interviews, to give applicants the opportunity to remedy the problem alleged by the examiner rather than dismissing the Appeal and abandoning this application.

To comply with this Petition, applicants have concurrently filed an RCE (and the fee), along with a Rule 114 Submission, amending the claims to remove the "means-plus-function" language, as well as placing allowable claim 5 in independent form.

Statement

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under Rule 137(b) was unintentional.

CONCLUSION

Applicants request that this application be placed back in the pending status.

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

16 MAY 2009

DATE

/Lyle Kimms/

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